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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,799	08/24/2001	Bettina Mockel	32301WD195	9044

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EXAMINER

KERR, KATHLEEN M

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/935,799

Applicant(s)

MOCKEL ET AL.

Examiner

Kathleen M Kerr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5,8-30,32,37-41,43,44 and 46 is/are pending in the application.
- 4a) Of the above claim(s) 12-26 and 28-30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5,8-11,27,32,37-41,43,44 and 46 is/are allowed.
- 6) ☒ Claim(s) 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Application Status***

1. In response to the previous Office action, a non-final rejection (mailed on June 16, 2004), Applicants filed a response and amendment received on August 31, 2004. Said amendment cancelled Claims 45 and 47 and amended Claims 9, 37, 39, 41, 43, and 44. Thus, Claims 5, 8-30, 32, 37-41, 43, 44, and 46 are pending in the instant Office action. Claims 12-26, and 28-30 remain withdrawn from consideration; Claims 5, 8-11, 27, 32, 37-41, 43, 44, and 46 and will be examined herein.

### ***Priority***

2. As previously noted, the instant application is granted the benefit of priority for the foreign application 100 42 051.6 filed in Germany on August 26, 2000 as requested in the declaration. Receipt was previously acknowledged of papers submitted under 35 U.S.C. § 119(a)-(d), which papers have been placed of record in the file. Applicants have also filed a certified translation of the German priority document.

### ***Withdrawn - Claim Objections***

3. Previous objection to Claims 9, 10, 41, 44, and 47 for containing arduous language is withdrawn by virtue of Applicant's amendment.

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***Withdrawn - Claim Rejections - 35 U.S.C. § 112***

4. Previous rejection of Claims 37, 43, and 46 under 35 U.S.C. § 112, second paragraph, as being indefinite is withdrawn by virtue of Applicant's amendment.

5. Previous rejection of Claims 39, 40, and 45 under 35 U.S.C. § 112, second paragraph, as being indefinite the fragment language is withdrawn by virtue of Applicant's amendment.

***Maintained - Claim Rejections - 35 U.S.C. § 112***

6. Previous rejection of Claim 43 under 35 U.S.C. § 112, first paragraph, enablement, as failing to comply with the enablement requirement is maintained. Applicant's arguments have been fully considered but are not deemed persuasive for the following reasons. Applicant argues that the amendment has obviated the rejection; the Examiner disagrees. The rejection is based on the fact that claim 37, from which Claim 43 depends, is drawn to a polynucleotide "consisting of" a specific sequence. Thus, only this sequence can be transformed into the bacterium. Without a vector-type structure, the bacterium would degrade the polynucleotide and, thus, not retain it. The specification does not enable transforming and retaining a polynucleotide consisting of SEQ ID NO:1 in any host cell as previously noted.

***Summary of Pending Issues***

7. The following is a summary of the issues pending in the instant application:
- a) Claim 43 stands rejected under 35 U.S.C. § 112, first paragraph, enablement, as failing to comply with the enablement requirement.

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***Examiner's Comment***

8. The Examiner would like to reiterate the relevancy of WO 01/00804 (Pompejus *et al.*, see IDS) with an international filing date of June 23, 2000 (published on January 4, 2001 and, thus, not available as prior art) claiming priority to three U.S. provisional applications with priority dates also before the earliest effective filing date of the pending claims. The teachings of Pompejus *et al.* are described in the Office action mailed September 9, 2003 - while SEQ ID NO:1 is not taught, a DNA encoding SEQ ID NO:2 is taught. Claims 5, 11, 27, 32, 41, and 46 (in part) are free of this art.

***Conclusion***

9. Claims 5, 8, 11, 27, 32, and 37-41, 44, and 46 are allowable. Claim 43 is rejected for the reasons identified in the numbered sections of this Office action. Applicants must respond to the objections/rejections in each of the numbered sections in this Office action to be fully responsive in prosecution.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (571) 272-0931.

The examiner can normally be reached on Monday through Friday, from 9:00am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen M Kerr  
Examiner  
Art Unit 1652

November 6, 2004